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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/004,107

Applicant(s)

WIRTH, JOHN

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner, specifically notes the following limitation added as part of the amendment filed 10/4/04. “whereby said low resolution scan file is reduced to a size that is as small as possible, while still providing a display with sufficient detail to allow a customer to recognize generally at least products imaged on said catalog page”.

Examiner notes that by defining the size of the low-resolution file based on the ability of a customer to recognize the products contains a significant amount of variables. For example, Applicant has no way of determining the quality of the customers vision, as an 80 year old customer would require much larger resolution than say a 20 year old customer. In addition, Applicant fails to describe how the present invention considers the customer’s monitor, as a 26 inch flat panel would handle a much smaller picture than say a 15 inch black and white monitor.

Examiner asserts that Applicant’s specification at the time of filing would not enable one of ordinary skill in the art to be able to define the size of the low resolution file by the ability of a

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customer to recognize a product in the file without undue or unreasonable experimentation. As such, the Applicant's specification is found to be lacking proper enablement.

Examiner notes that for the purpose of compact prosecution the size of the low resolution file will follow the old and well known concept of a "thumbnail" file. Examiner further references Microsoft Computer Dictionary Fourth Edition. Thumbnail: A miniature version of an image that is generally used to allow quick browsing through multiple images or pages. For example, Web pages often contain thumbnails of images (which can be loaded much more quickly by the Web browser than the full-size image). Many of these thumbnails can be clicked on to load the complete version of the image.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

[www.bartswatersports.com](http://www.bartswatersports.com) (hereinafter Barts).

Barts teaches an web-site stored on a first device connected to the Internet. Specifically what is store are low-resolution scans of the Bart's Water Sports catalog. When a user at a second device connected to the Internet requests the page the low resolution file is transmitted from the first device. Barts further teaches transmitting from the first device, in response to a request from the second device for a detailed product presentation, a detailed product presentation file.

Barts further teaches the ability to order the product on line (see Add to Shopping Cart feature).

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Barts also teaches the product description page contains a high resolution image, with a headline file identifying the product, a copy file containing a description of the product and an order block.

Barts also teaches a special page for items that are on sale (reference hyperlink titled "Web Specials").

Examiner notes that as Barts is an Internet Web-site the steps of transmitting a request for a page of a product catalog and transmitting a second request for a detailed product presentation are performed by a browser program stored on the second device. In addition, the steps of transmitting a low-resolution scan of the requested catalog page and transmitting detailed product presentation file are performed by a server program stored on the first device. Examiner notes that concrete evidence to support the previous statements has been provided. Specifically reference "How The Internet Works" page 127, which states that the Web operates on a client/server model. A user runs Web client browser software such as Netscape Navigator or Microsoft's Internet Explorer. The client contacts a Web server and requests information or resources. The Web server locates and then sends the information to the Web browser, which displays the results.

Barts further teaches that the product displayed on the low resolution scan can be a single item (reference A: 300 ft. Kevlar Spool Rope) or a plurality of items (reference B; Marine Snap Hooks). In addition where the product is a plurality of items the high-resolution photograph, the headline, the product copy and the order data block describe or reflect the plurality of items (reference the High Resolution Detail Description of Marine Snap Hooks). Where the product is a single item, the high-resolution photograph of the product, the headline, the product copy an

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the order data block describe or reflect the single item (reference the High Resolution Detail Description of the 300 ft Kevlar Spool Rope).

Examiner the Barts reference was found and the date detailed with "The WayBack Machine" at [www.archive.org](http://www.archive.org). The Internet Archive is a comprehensive library of Internet sites and other cultural artifacts in digital form. The Wayback Machine is a free service allowing people to access and use archived versions of past web pages within the Internet Archive. Visitors to the Wayback Machine can type in a URL, select a date range, and then will be able to search and view the Internet Archive's enormous collection of web sites, dating back to 1996 and comprising over 10 billion web pages.

Examiner further points to Barts reference B and notes that the image contains the text letters A-L. Examiner notes that this text is specifically used to identify and purchase the products presented on the catalog page. Examiner supports this assertion by referencing the bottom of the page. Each of the letters A-L correspond to a description of the item (identifying the item) followed by an order quantity text field (purchasing the product). As such the text is clearly used to identify and purchase the products.

Claims 1-78 are rejected under 35 U.S.C. 102(a) as being anticipated by [www.lillianvernon.com](http://www.lillianvernon.com) (Vernon).

Vernon teaches a web site which allows the user to view paper catalogs online (reference Vernon A). Specifically the user is given a list of the various paper catalog produced by Lillian Vernon and upon selection of a particular catalog is provided low resolution images of the exact pages from the paper catalog (Reference Vernon B & C).

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Examiner points to reference C and indicates that this low resolution image of the Lillian Vernon catalog contains text which comprises a category name (Gifts under \$10) and a headline for identifying said products and its benefits, copy describing said product and ordering information for purchasing product.

***Conclusion***

***Response to Arguments***

Applicant's arguments with respect to claims 1-78 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that the arguments made refer to either the low resolution amendment, which is rejected under 35 U.S.C. 112, first paragraph or to the newly added claims 51-78, which are rejected based on new grounds.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

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